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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,546	10/21/2005	William R. Freeman	1034123-000153	3894

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EXAMINER	
HUANG, GIGI GEORGIANA	
ART UNIT	**PAPER NUMBER**
1618	

MAIL DATE	DELIVERY MODE
07/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/531,546	FREEMAN, WILLIAM R.	
	Examiner	Art Unit	
	GiGi Huang	1609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2005*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-40* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-18 and 24, are drawn to a method for treating an ocular neovascular disease in a patient by identifying a feeder vessel in the choroidal neovasculature, administering a photosensitizer in an effective amount, delivering the photosensitizer to the feeder vessel, and exposing it to photoactivating light.

Group II, claims 19-23, are drawn to a method of treating an ocular neovascular disease by identifying the vessel, administering a photosensitizer, an anti-angiogenic factor, and delivering photodynamic therapy.

Group III, claims 25-30, are drawn to a system for performing photodynamic therapy on a feeder vessel in choroidal neovasculature.

Group IV, claims 31-39, are drawn to an apparatus for imaging and treating a feeder vessel associated with choroidal neovasculature.

2. Claim 40 provides for the use of a photosensitizer and photoactivating light but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 40 does not set forth any steps involved in the process, resulting in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The claim can be seen as a method of use or a method of manufacture. The applicant is encouraged to amend the claim to its proper form for examination purposes, and then the claim will be restricted into its own group if a method of manufacture, into Group I if commensurate in scope, or its own group for method of use if not commensurate in scope with the existing groups.

3. The groups may be subject to additional restriction dependent on the election.

4. The inventions listed as Groups I – IV and claim 40 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking Groups I – IV, and claim 40 is the method of using a photosensitizer with a photo activating light.

Strong et al. (U.S. Pat. # 5,756,541) teaches the use of photodynamic therapy with an effective amount of photoactive compound for the treatment of unwanted neovasculature in the eye, especially the choroid.

Diagnosed patients were treated with an effective amount of photoactive agent such as green porphyrins in a liposomal formulation, and irradiated at the wavelength absorbed by the agent selected (photodynamic therapy) yielding reduction or closure of

the neovascularization and improvement of visual acuity (Abstract, Col. 1, lines40-45, 65-68, Col. 2, lines 1-15, Col. 3, lines 50-61, Col. 4, lines 35-40, Col.6, lines 59-65).

Therefore, the technical feature linking the inventions of Groups I – IV and claim 40 does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art, thereby lacking novelty.

Accordingly, Groups I – IV and claim 40 are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even thought eh requirement can be traversed (37 CFR 10143) and (ii) identification of the claims encompassing the elected invention.

6. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should the applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GiGi Huang whose telephone number is (571) 272-9073. The examiner can normally be reached on Monday-Thursday 8:30AM-6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GH

ZOHREH FAY
PRIMARY EXAMINER
GROUP 1200

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